

REMARKS

This is in response to the Office Action mailed on March 25, 2004, in which claims 1-6 and 21-23 are allowed, claims 7-10, 12, 16, 17, and 20 are rejected, and claims 11, 13-15, 18, and 19 are objected to. Claims 11 and 21 have been amended to give proper antecedent basis to the claim.

Claims 7-10, 12, 16, 17, and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Soeno et al. (U.S. Patent No. 6,246,552). Claim 17, which depends from claim 7, has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Soeno et al. in view of applicant admitted prior art.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 8th ed. § 2131; citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Amended claim 7 includes a microactuator having a beam structure operatively connecting the rotor to the stator so as to permit movement of the rotor with respect to the stator, the beam structure and the slider being aligned in a plane defined by the microactuator.

Soeno et al. does not disclose the beam structure of claim 7 and the slider aligned in a plane defined by the microactuator. Soeno et al. shows in FIG. 9 an actuator 4 having displacement generating means 411a, 411b, 412a, 412b. However, “the operating principle of the actuator shown in FIG. 9 is the same as that of the actuator shown in FIG. 2 in respect of making use of the deflection of the displacement generating means.” (Soeno et al., col. 24, ll. 18-21). In the written description, the discussion of FIG. 9 is beneath the heading “Embodiment of the Invention Wherein the Actuator is Located on the Back Surface of the Slider.” (Soeno et al., col. 16, ll. 58-59). Therefore, Soeno et al. does not disclose the displacement generating means 411a, 411b, 412a, 412b and the slider 2 aligned in the plane defined by the microactuator.

Although Soeno et al. does disclose an “Embodiment of the Invention Wherein the Actuator is Located on the Side of the Slider,” as shown in FIG. 11, 12, and 13, Soeno et al. does not disclose the beam structure of claim 7 in an embodiment where the actuator is located on the side

of the slider. (Soeno et al., col. 25, ll. 65-69, col. 26, ll. 1-33). Further, Soeno et al. does not teach or suggest such a combination with the beam structure of claim 7. Therefore, because Soeno et al. does not teach, alone or in combination, the beam structure of claim 7 and the slider being aligned in a plane defined by the microactuator, claim 7 is not anticipated by Soeno et al.

Claims 8-10 and 12-17 depend from claim 7 and include all of the limitations of claim 7. Objected claims 11, 13-15, 18, and 19 also depend from claim 7 and include all of the limitations of claim 7. Because claim 7 is not anticipated by Soeno et al., neither are claims 8-19. Therefore, claims 8-19 are allowable.

Claim 17 is dependent upon claim 7, and therefore includes all of the limitations of claim 7. The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. MPEP § 2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. MPEP § 2143.01. Second, there must be a reasonable expectation of success. MPEP § 2143.02. Third, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCAP 1974); MPEP § 2143.03.

As discussed above with regard to claim 7, Soeno et al. does not disclose, alone or in combination, the beam structure of claim 7 and the slider aligned in the plane defined by the microactuator. Therefore, claim 17 is allowable as well. Further, applicant has made no admissions regarding the prior art of a beam structure. No combination of Soeno et al. with any of applicant's statements teaches, suggests, or discloses all of the limitations of claim 17. Therefore, claim 17 is not obvious in view of Soeno et al. with anything which may be considered admitted prior art.

Claim 20 requires a rotor attached to the slider where the rotor comprises a first portion for holding the slider and a second portion for holding an actuation element, and wherein the first portion and the second portion rotate about a rotation center. Soeno et al. does not disclose the claimed rotor having two portions. In Soeno et al. the displacement generating means 411a, 411b, 412a, 412b connect the rotor to the stator and are therefore not a portion of the rotor. Soeno et al.

shows a rotor having a single portion 44, (FIG. 9 of Soeno) not two portions that separately hold a slider and the actuation element. Because Soeno et al. does not teach each and every element of claim 20, claim 20 is not anticipated by Soeno et al. Therefore, claim 20 is allowable.

With regard to the reason for allowance of Claim 1, applicant would respectfully point to FIG. 6 and 7 as also showing the means for limiting deflection of the rotor out of a plane defined by the microactuator frame.

The above remarks place all pending claims 1-23 in allowable form. Applicant respectfully requests a notice of allowance for all pending claims 1-23.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 6/24/04

By: 

Gayle A. Bush, Reg. No. 52,677
THE KINNEY & LANGE BUILDING
312 South Third Street
Minneapolis, MN 55415-1002
Telephone: (612) 339-1863
Fax: (612) 339-6580

GAB:TDA:amh